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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,048	01/22/2002	Noriaki Abe	020011	1723
38834 7590 04/08/2008 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036				
EXAMINER				
AGWUMEZIE, CHARLES C				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/051,048

**Applicant(s)**

ABE ET AL.

**Examiner**

CHARLES C. AGWUMEZIE

**Art Unit**

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 6, 7 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-7, and 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB06)  
Paper No(s)/Mail Date 01/21/04; 02/02/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 4, 2008 has been entered.

### **Acknowledgments**

2. Applicants' amendment filed on January 4, 2008 is acknowledged. Accordingly claims 1-4, 6-7, and 19-26 remain pending.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-4, 6-7, and 19-26**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Finch U.S. patent No. 6,850,902 in view of Worger et al U.S. Patent No. 5,664,113 and further in view of Kerkinni U.S. Patent Application Publication No. 2002/0107833 A1.

5. As per claims 1 and 19, Finch discloses a method performed by a computer system for providing secondhand construction machine information, comprising:

a usage data collection step in which, usage data showing facts relating to usage of a plurality of construction machine are collected automatically, said collected usage data including (fig. 2; col. 1, lines 50-65; "...the age and hours of usage of the machinery...");

(a) usage field data for said each construction machine indicating a usage field in which said each construction machine has been used, said usage field being selected from among a plurality of usage fields which differ from each other as to workload placed on a construction machine (col. 1, lines 54-56; ... disclosed fields of usage include farm, lawn and industrial equipments...); and

(b) operating data for each said construction machine indicating operating hours of said each construction machine used in said usage field, (col. 1, lines 54-56; ... disclosed fields of usage include farm, lawn and industrial equipments...; col. 5, lines 37-40; ....hours of use on the equipment...);

a total operating hours determining step in which total operating hours by usage field for said each construction machine are determined based on the usage field data and the operating data for said each construction machine included in the usage data (col. 5, lines 37-40; ....hours of use on the equipment...);

and

a display displaying identification information of said plurality of usage fields and the total operating hours by usage field of a construction machine which is selected by a

customer from among said plurality of construction machine, are provided to the customer via a network, while said plurality of construction machine are being put up for sale as secondhand articles (fig. 1; col. 1, lines 10-20, 50-65; col. 2, lines 15-20; ...accessible by multiple levels of users...).

What Finch does not explicitly disclose is:

a usage data collection step in which, usage data showing facts relating to usage of a plurality of construction machine are collected automatically

a display displaying identification information of said plurality of usage fields and the total operating hours by usage field of a construction machine which is selected by a customer from among said plurality of construction machine, are provided to the customer via a network, while said plurality of construction machine are being put up for sale as secondhand articles.

Worger discloses:

a usage data collection step in which, usage data showing facts relating to usage of a plurality of construction machine are collected automatically (col. 2, lines 50-60, which discloses that "identification tags are attached to working assets to automatically communicate information to a database when the assets enter and leave various staging areas"; col. 15, lines 5-20, which discloses that working assets to automatically communicate information...)

Kerkinni discloses:

a display displaying identification information of said plurality of usage fields and the total operating hours by usage field of a construction machine which is selected by a

customer from among said plurality of construction machine, are provided to the customer via a network, while said plurality of construction machine are being put up for sale as secondhand construction machine (fig. 10, which discloses mileage report; 0044, which discloses that "the server database may then recall the usage information and display the usage information to the user 132....").

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Finch and incorporate a usage data collection step in which, usage data showing facts relating to usage of a plurality of construction machine are collected automatically; a display displaying identification information of said plurality of usage fields and the total operating hours by usage field of a construction machine which is selected by a customer from among said plurality of construction machine, are provided to the customer via a network, while said plurality of construction machine are being put up for sale as secondhand construction machine in view of Worger and Kerkinni respectively since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

6. As per claim 2, Finch failed to explicitly disclose a method, wherein said usage data collection step includes a step for collecting usage data for said plurality of articles by communicating with said plurality of articles from a remote location away from said plurality of articles.

Worger discloses a method, wherein said usage data collection step includes a step for collecting usage data for said plurality of construction machines by communicating with said plurality of construction machines from a remote location away from said plurality of construction machines (col. 3, line 60-col. 4, line 10, which discloses that assignment center 20 may, but need not, be located remotely from public and private staging areas 22 and 24).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Finch and incorporate the method, wherein said usage data collection step includes a step for collecting usage data for said plurality of construction machines by communicating with said plurality of construction machines from a remote location away from said plurality of construction machines in as taught by Worger because such service will facilitate real time update of the condition of the said construction machine information.

7. As per Claims 4, neither Finch, Worger nor Kerkinni expressly show a system wherein said usage data collection steps, said usage history storage step, and said usage history provision step are conducted simultaneously in parallel so that said plurality of construction machines still in use can be put up for sale as a secondhand construction machines.

However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The usage data collection steps, usage history storage step, and usage history provision step would be performed

the same regardless of the order. Thus, this descriptive material will not distinguish the claimed invention from prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide parallel processing of data because such data does not functionally relate to the steps in the method or system claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

8. As per claim 7, Finch further discloses a method further comprising a download step of downloading the usage history or service history for said plurality of articles, which are stored in said data base, to a terminal used by said customer via a network (col. 2, lines 15-50)

9. As per claims 21 and 23, Finch discloses the method, further comprising:

a usage data recollecting step in which, when said construction machine is used while said construction machine is being put up for sale as a secondhand construction machine, said usage data is recollecte

a total operating hours updating step in which the total operating hours by usage field are updated based on the usage field data and the operating data included in the recollecte



relating to among other things, ownership, financing, ...the age and hours of usage of the machinery...);

a usage data updating step in which the usage history of said construction machine stored in said data base are updated based on the recollected usage data (fig. 2; col. 1, lines 20-30, 50-65; "...up-to-date information relating to among other things, ownership, financing, ...the age and hours of usage of the machinery...); and

an updated usage history provision step in which the updated usage history stored in said data base and the updated total operating hours by usage field of the selected construction machine are provided to the customer via the network (fig. 2; col. 1, lines 20-30, 50-65; "...up-to-date information relating to among other things, ownership, financing, ...the age and hours of usage of the machinery...).

What Finch does not explicitly teach is:

a usage data recollecting step in which, when said construction machine is used while said construction machine is being put up for sale as a secondhand construction machine, said usage data is recollected.

Kerkinni discloses

a usage data recollecting step in which, when said construction machine is used while said construction machine is being put up for sale as a secondhand construction machine, said usage data is recollected (0044, which discloses that "the server database may then recall the usage information and display the usage information to the user 132").

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Finch and incorporate a usage data recollecting step in which, when said construction machine is used while said construction machine is being put up for sale as a secondhand construction machine, said usage data is recollecting in view of Kerkinni since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

10. As per claims 22 and 25, Finch discloses a computer system for providing information about secondhand construction machine, comprising:

usage data collecting step in which usage data that showing facts relating to usage of a plurality of construction machine are collected automatically, said collected usage data including attachment data for each construction machine indicating an attachment used by said each construction machine and operating data indicating operating hours of said each construction machine for respective attachments;

total operating hours determining step in which total operating hours by attachment being attached to each construction machine are determined based on the attachment data and the operating data included in the usage data (fig. 2; col. 1, lines 50-65; "...the age and hours of usage of the machinery...");

and

a provision step in which a display displaying identification information of said one or more attachments and the total operating hours by attachment for a construction machine which is selected by a customer are provided to the customer via a network, while said plurality of construction machine are being put up for sale as secondhand construction machine.

What Finch does not explicitly disclose is:

usage data collecting step in which usage data that showing facts relating to usage of a plurality of construction machine are collected automatically, said collected usage data including attachment data for each construction machine indicating an attachment used by said each construction machine and operating data indicating operating hours of said each construction machine for respective attachments and

a provision step in which a display displaying identification information of said one or more attachments and the total operating hours by attachment for a construction machine which is selected by a customer are provided to the customer via a network, while said plurality of construction machine are being put up for sale as secondhand construction machine.

Worger discloses:

usage data collecting step in which usage data that showing facts relating to usage of a plurality of construction machine are collected automatically, said collected usage data including attachment data for each construction machine indicating an attachment used by said each construction machine and operating data indicating operating hours of said each construction machine for respective attachments (col. 2,

lines 50-60, which discloses that "identification tags are attached to working assets to automatically communicate information to a database when the assets enter and leave various staging areas"; col. 15, lines 5-20, which discloses that working assets to automatically communicate information...)

Kerkinni discloses:

a provision step in which a display displaying identification information of said one or more attachments and the total operating hours by attachment for a construction machine which is selected by a customer are provided to the customer via a network, while said plurality of construction machine are being put up for sale as secondhand construction machine (fig. 10, which discloses mileage report; 0044, which discloses that "the server database may then recall the usage information and display the usage information to the user 132....").

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Finch and incorporate usage data collecting step in which usage data that showing facts relating to usage of a plurality of construction machine are collected automatically, said collected usage data including attachment data for each construction machine indicating an attachment used by said each construction machine and operating data indicating operating hours of said each construction machine for respective attachments; a provision step in which a display displaying identification information of said one or more attachments and the total operating hours by attachment for a construction machine which is selected by a customer are provided to the customer via a network, while said plurality of construction

machine are being put up for sale as secondhand construction machine in view of Worger and Kerkinni respectively since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

11. As per claim 24 and 26, Finch further discloses the computer system, wherein said one or more servers further perform:

recollecting said usage data of said plurality of construction machine when said plurality of construction machine has been used while said plurality of construction machine is being put up for sale as secondhand construction machine;

Storing the recollected usage data on said data base (fig. 1; col. 1, lines 10-20, 50-65; col. 2, lines 15-20);

updating the total operating hours by usage field based on the usage field data and the operating data included in the recollected usage data (fig. 2; col. 1, lines 20-30, 50-65; "...up-to-date information relating to among other things, ownership, financing, ...the age and hours of usage of the machinery..."); and

providing the updated total operating hours by usage field (fig. 1; col. 2, lines 15-20 col. 1, lines 20-30, 50-65; "...up-to-date information relating to among other things, ownership, financing, ...the age and hours of usage of the machinery...).

What Finch does not explicitly teach is

recollecting said usage data of said plurality of construction machine when said plurality of construction machine has been used while said plurality of construction machine is being put up for sale as secondhand construction machine.

Kerkinni discloses:

recollecting said usage data of said plurality of construction machine when said plurality of construction machine has been used while said plurality of construction machine is being put up for sale as secondhand construction machine (0044, which discloses that "the server database may then recall the usage information and display the usage information to the user 132")

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Finch and incorporate recollecting said usage data of said plurality of construction machine when said plurality of construction machine has been used while said plurality of construction machine is being put up for sale as secondhand construction machine in view of Kerkinni since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

12. Claims 3, and 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Finch U.S. patent No. 6,850,902 in view of Worger et al U.S. Patent No. 5,664,113

and Kerkinni U.S. Patent Application Publication No. 2002/0107833 A1 and further in view of Ukai U.S. Patent Application Publication No. 2003/0191581 A1.

13. As per claim 3, and 20, neither Finch, Worger nor Kerkinni explicitly discloses a method further comprising:

a service data collection step in which, service data that show the facts relating to the service of the said plurality of construction machine are collected, when said plurality of construction machine has been serviced;

a service history storage step in which collected service data are stored as service history in said data base; and

a service history provision step in which, the service history for said selected construction machine stored in said data base, is provided to a customer via a network, when said plurality of construction machine is being put up for sale as a secondhand construction machine

Ukai et al discloses a service data collection step in which, service data that show the facts relating to the service of the said plurality of construction machine are collected, when said plurality of construction machine has been serviced (fig. 6; 0103; 0133; 0134; 0137);

a service history storage step in which collected service data are stored as service history in said data base (fig. 6; 0103; 0133; 0134); and

a service history provision step in which, the service history for said selected construction machine stored in said data base, is provided to a customer via a network,

when said plurality of construction machine is being put up for sale as a secondhand construction machine (fig. 2, 5; 0133; 0134; 0137)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Finch and incorporate the ability to provide a service history data, while said construction machine is being put up for sale as a secondhand article, service history data are provided to the customer via the network as taught by Ukai et al in order to make available the service history data immediately available to the potential customer for the purposes of evaluating the condition of the article before purchase.

14. **Claim 6**, is rejected under 35 U.S.C. 103(a) as being unpatentable over Finch U.S. Patent 6,850,902 in view of Worger et al U.S. Patent No. 5,664,113 and Kerkinni U.S. Patent Application Publication No. 2002/0107833 A1 and further in view of Rose Jr. (herein after "Rose") U.S. Patent No. 6,076,064.

15. As per **claim 6**, neither Finch, Worger nor Kerkinni explicitly discloses a method wherein said usage data includes photographic data showing actual images of said construction machine.

Rose discloses a method wherein said usage data includes photographic data showing actual images of said construction machine (col. 7, lines 20-40).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Finch and incorporate the ability to



provide a usage data wherein said usage data includes photographic data showing actual images of said construction machine as taught by Rose in order to make available the actual images and current state of the construction machine visually apparent to potential customer before purchase.

### ***Response to Arguments***

16. Applicant's arguments with respect to claims 1-4, 6-7, and 19-26 have been considered but are moot in view of the new ground(s) of rejection.

However respect to claims 1, 19, 22 and 25, Applicant argues that information in Finch is inputted manual as contrasted with Applicants invention in which usage data showing facts relating to usage of a plurality of construction machines are collected automatically.

In response, Examiner submits that despite the fact that Worger does disclose the automatic collection of usage data as provided in the rejection above, Applicant is reminded that automating a manual activity does not patentably distinguish the claimed invention from the prior arts. Such automation is obvious modification of the prior art. See In re Venner, 120 USPQ 192 (CCPA 1958), In re Smith 73 USPQ 394 (If a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention; It is not invention to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result).

***Conclusion***

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Hagenbuch U.S. Patent No. 5,650,928 is a document considered relevant to the claimed invention.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on **(571) 272 – 6779**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For

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**/Charlie C Agwumezie/  
Primary Examiner, Art Unit 3621  
March 24, 2008**